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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/868,256	07/15/01	TANAKA	H AA374F

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THE PROCTER & GAMBLE COMPANY
PATENT DIVISION
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EXAMINER

YU, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Applicati n N .

09/868,256

Applicant(s)

TANAKA ET AL.

Examin r

Gina C. Yu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Specification***

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in patent procedure. The specification states that the term "comprising" in claims encompass "consisting of" and "essentially consisting of". See spec. 3, lines 1-3. Applicant's terminology is unacceptable because the terms "comprising", "consisting of", and "essentially consisting of" are different transitional phrases used to define the scope of a claim, and may not be used in place of one another. See MPEP § 2111.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "comprising" in claims 1, 7, 8, and 10 are used by the claim to encompass "consisting of" and "essentially consisting of". See spec. 3, lines 1-3. As discussed above, these the scope of a claim varies depending on these transitional phrases, therefore these phrases may not be used in place of one another. See MPEP § 2111.03.

The term "substantially" in claim 1 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard

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for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "ratio" in claims 2-5 are vague because it is not clear whether the measurement is in weight or volume.

Claim 8 is vague because it is not clear whether the percentage of the components are in weight, volume, or moles.

Claim 4 recites the limitation "polyoxyethylene castor oil ester" in claim 2, which refers to claim 1. There is insufficient antecedent basis for this limitation in the claim.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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1. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumida (JP448925, Translation).

Sumida teaches transparent microemulsion composition comprising (a) 0.1-30.0wt % of nonionic surfactants which include polyoxyethylene castor oil or hardened castor oil derivatives and polyoxyethylene sorbitan trioleate; (b) 0.001-20 wt % of ionic surfactants which include polyoxyethylene alkyl ether phosphate; (c) 0.1-30wt % of oil; and (d) 40-99 wt % of water. See Translation, p. 2 – p. 6. Example 1 on p. 8 shows the use of polyhydric alcohol. The types of oil and additives which may be used for the invention are also discussed. The reference further teaches that the preferred ratio of nonionic surfactant to oily substance is 1: 1-3, which meets instant claim 2. It teaches that at a high ratio of surfactant to oil the skin safety and feel are degraded, see p. 3, last paragraph. The reference further teaches that the preferred ratio of ionic surfactant to oil is 1:0.01-2.0. See p. 6, paragraph 3. Although the specific ratio of each surfactants are not disclosed in the reference, examiner views that given the teachings of the preferred surfactants and their amounts in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.

2. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayanagi et al. (U.S. Pat. No. 5474776) ("Kayanagi").

Kayanagi teaches transparent cosmetic composition comprising (a) hydrophilic nonionic surfactants which may include the surfactants of instant claim 1 (a); (b) liquid oil; (c) water-soluble compound which may include polyhydric alcohol; (d) water. See abstract; col. 2, line 23 – col. 6, line 27. The reference mentions polyoxyethylene sorbitan fatty acid ester and polyoxyethylene hardened castor oils are particularly preferred, and may teaches that the surfactants may be used singly or in combination, meeting instant claim 1. See col. 3, lines 33 –

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37. instant claim 6 is met by the disclosure of the types of oil used in the invention in col. 4, lines 50 – 67. The additives are disclosed in col. 6, lines 2 – 12, meeting instant claim 7. The reference further teaches that (a) 1-30 wt % of surfactants (b) 1-60 wt % of liquid oil; (c) 10-70 wt % of water-soluble compound; and (d) 1-87.99 wt % of water, and instant claim 8 is met.

Although the specific ratio of each surfactants are not disclosed in the reference, examiner views that given the teachings of the preferred nonionic surfactants and the total amount of the surfactants in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 2, 2001


DIANA DUDASH
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